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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221326
Party	Defendant CityCenter Land, LLC
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Submission	Motion for Summary Judgment
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Date	08/29/2016
Attachments	91221326 Applicants Motion for Summary Judgment.pdf(16060 bytes) 91221326 Exhibit 1_Gordon Declaration w Exh A ISO M for SJ.pdf(89288 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hollywood Entertainment, LLC dba Avalon
and dba Bardot,

Opposer,

v.

CityCenter Land, LLC,

Applicant.

Opposition No. 91221326

Mark: BARDOT

Serial No. 86/243405

Published: March 3, 2015

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56(a) and Trademark Rule 2.127(e), Applicant CityCenter Land, LLC ("CityCenter") hereby moves for summary judgment against Opposer Hollywood Entertainment, LLC and requests that the Board deny the Opposition and allow CityCenter's application to proceed to registration. As discussed below, no genuine disputes of material fact exist, and summary judgment is therefore warranted as a matter of law.

I. BACKGROUND

CityCenter owns a pending federal trademark application for BARDOT, Serial No. 86/243405, for "Restaurant services; bar services" in Class 43 ("CityCenter's Application"). CityCenter's Application was filed on April 4, 2014 and published for opposition on March 3, 2015. Opposer also owns a pending federal trademark application for BARDOT, Serial No. 86/245158 ("Opposer's Application"), that was filed on April 7, 2014, three days after CityCenter's Application was filed.

On April 1, 2015, Opposer filed the present Opposition on the grounds of priority of use and likelihood of confusion, alleging that: (a) Opposer, since at least December 2008 has been and now is using the mark BARDOT in connection with restaurant and bar services (*see* Notice of Opposition, Docket No. 1, ¶¶ 2-3); and (b) CityCenter's BARDOT mark is "likely to cause

confusion, or to cause mistake, or to deceive” and may “disparage and falsely suggest a connect [sic] with Opposer (*See id.*).”

CityCenter files this Motion for Summary Judgment because discovery has confirmed that there is no genuine dispute that (a) Opposer does not use and has not used the mark BARDOT for restaurant and bar services as alleged in its Notice of Opposition and therefore does not have priority; and (b) there is no likelihood of confusion as to the source or sponsorship of the goods and services designated by Opposer’s BARDOT mark and the goods and services designated by CityCenter’s BARDOT mark. Thus, Opposer’s claims must fail as a matter of law and judgment should be entered in favor of CityCenter.

II. OPPOSER’S ADMISSIONS SUPPORT GRANTING APPLICANT’S MOTION

Fed. R. Civ. P. 36(a)(4) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither. An admission in response to a request for admission “conclusively establishe[s]” the matter that is the subject of that request. Fed. R. Civ. P. 36(b). “This conclusive effect applies to those admissions made affirmatively and those established by default, even if the matters admitted relate to material facts that defeat a party’s claim.” *Am. Automobile Ass’n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (*citing United States v. Kasuboski*, 834 F.2d 1345, 1350 (7th Cir. 1987)); *see also Fox Rest. Concepts LLC*, 91208911, 2014 WL 5908011 (T.T.A.B. 2014).

In the present case, CityCenter served its First Requests for Admission on counsel for Opposer via First-Class Mail on June 3, 2016. Exhibit 1, Declaration of Zachary T. Gordon (“Gordon Decl.”) at ¶ 2. Pursuant to Fed R. Civ. P. 36(a), Opposer had thirty (30) days to respond. At the time of filing this Motion for Summary Judgment, Opposer has still not responded to CityCenter’s First Requests for Admission. Gordon Decl. at ¶ 3. As now more than 80 days have passed since CityCenter mailed its written discovery to Opposer, CityCenter’s First Requests for Admission are deemed admitted pursuant to Fed. R. Civ. P. 36(b).

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III. STATEMENT OF UNDISPUTED FACTS

Opposer has admitted the following:

1. Neither Opposer nor its subsidiaries, parents, affiliates, licensees, and their respective officers, directors, employees, agents, and predecessors-in-interest (the “Opposer Parties”) currently operate a restaurant under the name BARDOT. Gordon Decl. at ¶ 2, Exhibit A, No. 3.

2. The Opposer Parties have not operated a restaurant under the name BARDOT since December of 2008. Gordon Decl. at ¶ 2, Exhibit A, No. 4.

3. The Opposer Parties do not currently operate a bar under the name BARDOT. Gordon Decl. at ¶ 2, Exhibit A, No. 5.

4. The Opposer Parties have not operated a bar under the name BARDOT since December of 2008. Gordon Decl. at ¶ 2, Exhibit A, No. 6.

5. The consumers of the services that the Opposer Parties offer under the BARDOT mark are sophisticated. Gordon Decl. at ¶ 2, Exhibit A, No. 12.

6. The Opposer Parties are not aware of any instances of actual confusion due to the Opposer Parties’ use of BARDOT and Applicant’s use of BARDOT. Gordon Decl. at ¶ 2, Exhibit A, No. 13.

7. There is no likelihood of confusion as to the source or sponsorship of the goods and services designated by the Opposer Parties’ BARDOT mark and the goods and services designated by Applicant’s BARDOT Mark. Gordon Decl. at ¶ 2, Exhibit A, No. 14.

IV. ARGUMENT

A. Summary Judgment Standard

A motion for summary judgment is a pretrial device to dispose of cases in which there is no genuine dispute as to any material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The party moving for summary judgment has the burden of demonstrating that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* TBMP § 528.01; *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats*

Fashions Inc. v. Pannill Knitting Co. Inc., 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987). A fact is material if it “may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings.” *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992). The Board does not hesitate to dispose of cases on summary judgment when appropriate. TBMP § 528.01.

To prevail on its claims, Opposer must prove that it has priority of use and that contemporaneous use of the parties’ respective marks in connection with their respective services would be likely to cause confusion, mistake, or to deceive consumers. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1735 (T.T.A.B. 2001). The undisputed material facts demonstrate that Opposer does not have priority and that there is no likelihood of confusion. Thus, the Board should find that no genuine issue of material fact exists and should grant CityCenter’s motion.

B. Opposer Lacks Priority

To establish priority, Opposer must establish that it has proprietary rights in its BARDOT mark. *See Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co. v. Universal Foods Corp.*, 209 U.S.P.Q. 40, 43 (C.C.P.A. 1981). Proprietary rights may arise from a prior registration, prior trademark use, prior use as a trade name, or prior use analogous to trademark use. *Id.* The allegation in Opposer’s Application of a date of use is insufficient to establish priority. *See* Trademark Rule 2.122(b). Likewise, Opposer’s specimen submitted as part of Opposer’s Application is not evidence of Opposer’s priority or that Opposer has used the mark. *Id.*

To date, Opposer has not submitted any evidence of use prior to the April 4, 2014 filing date of CityCenter’s Application. Moreover, Opposer admits that it does not and has not used its BARDOT mark in connection with bar or restaurant services as it alleged in its Notice of Opposition. Gordon Decl. at ¶ 2, Exhibit A, Nos. 3-6. Accordingly, Opposer lacks priority.

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C. There is No Likelihood of Confusion

The test for likelihood of confusion requires an application of thirteen factors, the relevance of each depending on the nature of the case. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Opposer admits that many factors weigh against a finding of likelihood of confusion, such as that the consumers of its services are sophisticated and that it is not aware of any instances of actual confusion. Gordon Decl. at ¶ 2, Exhibit A, Nos. 12-13. Nevertheless, application of the *du Pont* factors is unnecessary as Opposer admits that there is no likelihood of confusion as to the source or sponsorship of the goods and services designated by Opposer's BARDOT mark and the goods and services designated by CityCenter's BARDOT mark. Gordon Decl. at ¶ 2, Exhibit A, No. 14. As Opposer's admission conclusively establishes the matter, there is no genuine dispute as to the fact that there is no likelihood of confusion.

V. CONCLUSION

For the reasons set forth above, CityCenter respectfully requests that the Board grant summary judgment in favor of CityCenter and deny Opposer's Opposition.

Dated this 29th day of August, 2016.

Respectfully submitted,

LEWIS ROCA ROTHGERBER CHRISTIE LLP

/S/ Michael J. McCue

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Zachary T. Gordon

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Counsel for Applicant

CERTIFICATE OF SERVICE

I hereby certify that, on this 29th day of August 2016, a true and complete copy of the foregoing Motion for Summary Judgment, and Exhibit 1 - Declaration of Zachary T. Gordon in Support of Applicant's Motion For Summary Judgment and its attached Exhibit A, were served by United States mail, first class postage prepaid, on the following counsel of record for Applicant:

Christie Gaumer
Law Offices of Christie Gaumer
3940 Laurel Canyon Blvd., No. 733
Studio City, Ca 91604

Counsel for Opposer

/s/ Joy A. Jones, CP
An employee of Lewis Roca Rothgerber Christie LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hollywood Entertainment, LLC dba Avalon
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v.

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Opposition No. 91221326

Mark: BARDOT

Serial No. 86/243405

Published: March 3, 2015

**DECLARATION OF ZACHARY T. GORDON IN SUPPORT OF
APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

I, Zachary T. Gordon, declare under penalty of perjury under the laws of the United States as follows:

1. My name is Zachary T. Gordon, and I am an attorney admitted to practice in the state of Nevada. I am an associate with the law firm Lewis Roca Rothgerber Christie LLP, which represents Applicant CityCenter Land, LLC ("CityCenter") in this matter. I am competent to make this Declaration, and I have personal knowledge of the following facts, which are true and correct to the best of my knowledge, and am competent to testify thereto.

2. Attached hereto as Exhibit A is a copy of CityCenter's First Requests for Admission served on counsel for Opposer Hollywood Entertainment, LLC via First-Class Mail on June 3, 2016.

3. At the time of filing this Motion for Summary Judgment, Opposer has not responded to CityCenter's First Requests for Admission.

Dated this 29th day of August, 2016.

Respectfully submitted,

/S/ Zachary T. Gordon

Zachary T. Gordon

EXHIBIT A

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HOLLYWOOD ENTERTAINMENT, LLC dba))	
AVALON and dba BARDOT,)	
)	
Opposer,)	
)	Opposition No. 91221326
vs.)	
)	Serial No. 86/243405
CITYCENTER LAND, LLC,)	
)	
Applicant.)	
_____)	

APPLICANT'S FIRST REQUESTS FOR ADMISSION

Pursuant to 37 C.F.R. § 2.120 and Rule 36 of the Federal Rules of Civil Procedure, Applicant CityCenter Land, LLC serves these Requests for Admission upon Opposer Hollywood Entertainment, LLC and requests that Opposer respond to these requests in writing and under oath within thirty days of services.

DEFINITIONS

1. "You" or "your" refers to Hollywood Entertainment, LLC, its subsidiaries, parents, affiliates, licensees, and their respective officers, directors, employees, agents, and predecessors-in-interest.

2. "Your Cited BARDOT Mark" means any trademark or service mark owned or used by You containing the word "BARDOT", with or without a stylized font, and alone or in connection with other letters, numbers, words or designs, including, but not limited to, the BARDOT mark application cited in Opposer's Notice of Opposition, and that is the subject of U.S. trademark application bearing the Serial No. 86/245158.

3. “Applicant’s BARDOT Mark” means the trademark that is the subject of U.S. trademark application bearing the Serial No. 86/243405.

4. The term “and” includes “or” and vice versa.

5. The terms “any” and “all ” shall include “each and every.”

INSTRUCTIONS

Under Rule 36 of the Federal Rules of Civil Procedure, You must specifically admit or deny the following Requests for Admission. If You cannot truthfully admit or deny a Request, You must state in detail why You cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter; and when good faith requires that You qualify an answer or deny only a part of a matter, the answer must specify the part admitted and qualify or deny the rest. You may assert lack of knowledge or information as a reason for failing to admit or deny only if You state that You have made reasonable inquiry and that the information You know or can readily obtain is insufficient to enable You to admit or deny.

REQUESTS FOR ADMISSION

1. Admit that in an amendment to allege use to Your United States trademark application no. 86/245158 for the BARDOT mark, you allege that You have used the BARDOT mark in connection with “food establishment, namely, café, restaurant” since December 1, 2008.

2. Admit that Your Notice of Opposition in this action states that “Opposer, since at least December of 2008, has been, and is now, operating a restaurant and bar under the name BARDOT.”

3. Admit that You do not currently operate a restaurant under the name BARDOT.

4. Admit that You have not operated a restaurant under the name BARDOT since December of 2008.

5. Admit that You do not currently operate a bar under the name BARDOT.

6. Admit that You have not operated a bar under the name BARDOT since December of 2008.

7. Admit that Your United States trademark application no. 86/245158 for the BARDOT mark alleges that You have used the BARDOT mark in connection with “hotel services” since December 1, 2008.

8. Admit that You do not currently offer hotel services under the BARDOT mark.

9. Admit that You have not offered hotel services under the BARDOT mark since December of 2008.

10. Admit that You have not used Your Cited BARDOT Mark in commerce in connection with any goods or services offered outside of Los Angeles County, California.

11. Admit that You do not intend to use Your Cited BARDOT Mark in commerce in connection with any goods or services outside the state of California.

12. Admit that consumers of the services You offer under Your Cited BARDOT Mark are sophisticated.

13. Admit that You are not aware of any instances of actual confusion due to Your use of Your Cited BARDOT Mark and Applicant’s use of Applicant’s BARDOT Mark.

14. Admit that there is no likelihood of confusion as to the source or sponsorship of the goods and services designated by Your Cited BARDOT Mark and the goods and services designated by Applicant’s BARDOT Mark.

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Dated this 3rd day of June, 2016.

LEWIS ROCA ROTHGERBER CHRISTIE LLP

By: 

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Fax: 702-949-8363
Attorneys for Applicant

CERTIFICATE OF SERVICE

I, Tammy L. Bunch, hereby certify that a true and accurate copy of the foregoing **APPLICANT'S FIRST REQUESTS FOR ADMISSION** has been served upon all parties, at their address of record, as shown below, by First Class Mail, postage prepaid, on this 3rd day of June, 2016.

Address listed with the TTAB:

Christie Gaumer, Esq.
3940 Laurel Canyon Blvd., No. 733
Los Angeles, CA 90028

**Address in Opposition Signature Block and
verified with USPS.com:**

Christie Gaumer, Esq.
LAW OFFICES OF CHRISTIE GAUMER
3940 Laurel Canyon Blvd., No. 733
Studio City, CA 91604

/s/ Tammy L. Bunch
An employee of Lewis Roca Rothgerber LLP